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SEP 14 2005
Director's Office
Group 3700

In re Application of
WILLIAMS ET AL.
Application No.: 09/941,475
Filed: August 29, 2001

DECISION ON PETITION

This application is before the Director of Technology Center 3700 for reconsideration of the Notice of Abandonment mailed October 2, 2002. In view of the statements in the letter received October 15, 2002 and resubmitted April 26, 2005, the submission is being treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment in the above-identified application. No fee is required.

The petition is granted.

A review of the file history indicates that applicant filed a non-publication request with the filing of the application on August 29, 2001 certifying that the invention disclosed in this application has not and will not be the subject matter of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing of the application. MPEP 1122 states, in part:

“A nonpublication request is not appropriate unless the person who is signing the nonpublication request has made an actual inquiry consistent with the requirements of 37 CFR 10.18(b) to determine that:

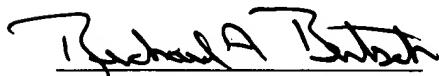
- (A) The application under 35 U.S.C. 111(a) has not been the subject of a foreign or international application filed in another country, or under a multilateral international agreement, that requires publication of applications at eighteen months after filing (e.g., a counterpart PCT application); and
- (B) The applicant’s intent at the time the nonpublication request is being filed is that the application under 35 U.S.C. 111(a) will not be the subject of a foreign or international application filed in another country, or under a multilateral international agreement, that requires publication of applications at eighteen months after filing.

Only when both conditions are satisfied, can applicants file a nonpublication request under 37 CFR 1.213(a)...A nonpublication request is also not appropriate if the applicant has not yet made a decision whether to file a counterpart application in a foreign country, or under a multilateral international agreement, that requires publication of applications at eighteen months after filing. A certification under 37 CFR 1.213(a)(3) cannot be made based on a lack of knowledge of the applicant's plans concerning the filing of any counterpart application that would be subject to eighteen-month publication or the applicant's past practices or tendencies with respect to the filing of foreign counterpart applications...The applicant must have an affirmative intent not to file a counterpart application, and not just the absence of any intent or plan concerning the filing of any counterpart application that would be subject to eighteen-month publication. A nonpublication request is only appropriate if the applicant's intent at the time the nonpublication request is being filed is not to file a counterpart foreign or international application that would be subject to eighteen-month publication."

The examiner held the application abandoned upon the discovery of a subsequently filed PCT application (PCT US02/18047, filed June 2, 2002) that contains the same subject matter as the present application. At the time the case was held abandoned, the file history did not contain a request to rescind the non-publication request or the notice of foreign or international filing that is required within 45 days of the filing of PCT application. Applicant/Petitioner has supplied a copy of the request to rescind the non-publication request and the notice of foreign or international filing and a copy of the postcard receipt dated June 14, 2002 establishing that the papers were timely filed in the office within 45 days of the filing of the PCT application.

In view of the above, the Notice of Abandonment mailed October 2, 2002 is in error and is hereby vacated. The holding of abandonment is withdrawn. The application will be returned to an active status and forwarded to the examiner for an action on the merits.

Summary: Holding of Abandonment Withdrawn.



Richard A. Bertsch, Director
Technology Center 3700